

II. REMARKS

Claims 127 and 129 are pending.

A. Regarding non-statutory subject matter

The Action rejects claim 129 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicants respectfully traverse the rejection.

The Action suggests amending this claim to overcome this rejection. Accordingly, to promote prosecution of this case to finally reach allowance, claim 129 has been amended herein to require that the recited composition be "purified." This amendment is supported in the specification, for example, at page 65, lines 5 to 15, which discloses that the protein of the invention can be purified (and how this can be done). In light of this amendment, Applicants respectfully request that this rejection be withdrawn.

B. Regarding double patenting

The Action rejects claims 127 and 129 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claim 1 of U.S. Pat. No. 6,426,209 B1 (the '209 patent). Applicants respectfully traverse the rejection.

In order for obviousness-type double patenting to apply, both the cited reference and the subject invention must be "commonly owned," which means that both must be "wholly or entirely owned by the same person or organization." See MPEP sec. 804.03 (II) (A). (See also sec. 706.02 (I) (2) for a detailed definition of "common ownership.")

In the present case, the subject invention is co-owned by two entities: (A) InSight Strategy and Marketing Ltd. ("InSight"); and (B) Hadasit Medical Research Services and Development Ltd. By contrast, the '209 patent is exclusively owned by InSight.

In view of these facts, Applicants respectfully request that this rejection be withdrawn.

C. Regarding this Action

Applicants respectfully note that the Examiner has taken the very unusual step of reopening prosecution after the previous Action, which was a Quayle Action, had closed prosecution. Applicants further note that the double patenting rejection of the claims, while inapplicable for the reasons discussed above, could have been made at any point during the long, tortuous and extremely expensive prosecution of this case. Certainly, both rejections in this case could have been made earlier.

While Applicants appreciate the Examiner's thoroughness in general, and in this case in particular, Applicants certainly hope and indeed expect that the above amendment and facts discussed above have mercifully brought an end to the case, resulting in allowance of pending claims 127 and 129.

III. CONCLUSION

All of the issues raised in the Office Action have been addressed and are believed to have been overcome. Therefore Applicants respectfully request a Notice of Allowance to this effect.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Martin D. Moynihan", written in a cursive style.

Martin Moynihan,
Registration Number 40,338

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Enc.

One-month extension of time